

REMARKS

The application has been reviewed in light of the Advisory Action dated November 30, 2006 and the final Office Action dated August 22, 2006. Claims 1-12, 17 and 18 were pending. Claims 13-16 were previously canceled, without prejudice or disclaimer. By this Amendment, claim 18 has been canceled, without prejudice or disclaimer, and replaced by new independent claim 19, and claims 1 and 6 have been amended to clarify the claimed subject matter. Accordingly, claims 1-12, 17 and 19 are now pending and presented for continued examination, with claims 1, 6 and 19 being in independent form.

Claims 1-6, 8-12, 17 and 18 were rejected under 35 U.S.C. § 102(e) as purportedly anticipated by Arunapuram et al. (US 2002/0019759 A1). Claim 7 was rejected under 35 U.S.C. § 103(a) as purportedly unpatentable over Arunapuram.

Applicant has carefully reconsidered the Examiner's comments and the cited art, and respectfully submits that independent claims 1, 6 and 18 are patentable over the cited art, since (i) Arunapuram is not prior art to the claimed subject matter of this application, and (ii) the cited art fails to teach or suggest each and every feature of the claimed subject matter, as required for anticipation under 35 U.S.C. § 102(e) {or obviousness under 35 U.S.C. § 103}.

Arunapuram (U.S. Application Publication No. 2002/0019759 A1) is a publication of U.S. application Serial No. 09/882,257, filed June 18, 2001, which claims the benefit of U.S. provisional application no. 60/212,124, filed June 16, 2000. However, Arunapuram is not entitled to the June 16, 2000 filing date of U.S. provisional application no. 60/212,124 as an effective reference date, since provisional application no. 60/212,124 does not comply with the requirements of 35 U.S.C. § 119(e) [see MPEP 706.02(f)(1), Example 2: a publication of a 35 U.S.C. § 111(a) application

which claims the benefit of a prior U.S. provisional application can be accorded the filing date of the earlier filed provisional application, only if the earlier filed provisional application meets the requirements of 35 U.S.C. §119(e)]. 35 U.S.C. §119(e) provides that a 35 U.S.C. §111(a) application which claims the benefit of a prior U.S. provisional application can be entitled to the benefit of the earlier filed provisional application, only if (i) the earlier filed provisional application meets the requirements of 35 U.S.C. §112, and (ii) 35 U.S.C. §111(a) application is filed no later than 12 months after the provisional application was filed. In other words, as the Federal Circuit pointed out in New Railhead Manufacturing, L.L.C. v. Vermeer Manufacturing Co., 298 F.3d 1290, 1294 (Fed.Cir. 2002), the specification of the provisional must contain a written description of the invention and the manner and process of making and using it, in such full, clear, concise, and exact terms to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application. Thus, in order for a 35 U.S.C. §111(a) application to have the filing date of the earlier filed provisional application as the effective reference date with respect to certain subject matter (here, that which is described in the claims of the present application), the earlier filed provisional application must provide a written description of such subject matter and the manner and process of making and using it, in such full, clear, concise, and exact terms to enable an ordinarily skilled artisan to practice the subject matter.

Here, Provisional Application no. 60/212,124 of Arunapuram does not comply with such requirements of 35 U.S.C. §112, and simply does not teach or suggest the subject matter of the current claims of the present application.

If the Examiner should disagree therewith, Applicant requests the Examiner to cite to the specific portions of Provisional Application no. 60/212,124 where disclosure of the features of the

claims of the present application can be found.

For example, the subject matter of claim 1 of the present application provides for a method for managing shipping charges for transportation of items by a shipping entity from one or more actual locations of a supplier to customer locations, including (1) providing first shipping charges related to actual charges by the shipping entity to the supplier for transportation of items by the shipping entity from the one or more actual supplier locations to the customer locations, (2) providing second shipping charges to the customer related to shipping charges for the items calculated by reference to charges applicable to shipment of the items to the customers from one or more virtual supplier locations that are different from the one or more actual supplier locations, (3) computing differences between the first shipping charges and the second shipping charges, and (4) utilizing the computed differences, after the second shipping charges have been billed to the customer, for one or more of internal management of shipping costs, cost accounting, allocation of costs and product planning.

Provisional application no. 60/212,124 of Arunapuram is directed to a transportation system and method which provides optimization of shipping routes and schedules, price forecasting, supply chain integration, and tracking and tracing of shipments in transit. Such functionalities are proposed by Arunapuram for automatic selection of carriers, shipping routes and schedules, based on processing of (a) order information, such as source and destination, time frame, type of transport desired, etc., (b) carrier information, such as types, prices, etc., of transport available from the carrier, and (c) constraint information which describes what solutions are not suitable or possible.

Although Provisional application no. 60/212,124 briefly mentions “freight allocation methods, which allows the client to manage his freight costs at many different levels, such as item,

product family, sales territory, customer, etc.”, such a casual statement, without further details, does not meet the requirements under 35 U.S.C. §112 of a written description ... in such full, clear, concise, and exact terms to enable an ordinarily skilled artisan to practice the invention claimed in the non-provisional application.

Applicant maintains that neither Provisional application no. 60/212,124 nor US 2002/0019759 A1 teaches or suggests several of the features of the claimed subject matter.

For example, Arunapuram does not teach or suggest providing first shipping charges related to actual charges by the shipping entity to the supplier for transportation of items by the shipping entity from the one or more actual supplier locations to the customer locations.

Arunapuram, [0077], proposes that one of a plurality of possible multi-leg routes for shipping an order is selected based on consideration of the estimated costs of the routes, and possible consolidations with other orders in one or more legs of the selected route.

However, while Arunapuram mentions considering estimated costs, Arunapuram neither teaches nor suggests providing first shipping charges related to actual charges by the shipping entity to the supplier for transportation of items by the shipping entity. Stated another way, Arunapuram is concerned with trip planning (that is, before a shipment is made). In contrast, the subject matter of claim 1 of the present application relates to managing actual shipping charges, after the charges have been made by the shipping entity to the supplier.

In addition, while Arunapuram proposes allocating cost of a route to the multiple legs of the route according to weighted distance, Arunapuram neither teaches nor suggests computing differences between the first shipping charges (that is, actual charges by the shipping entity to the supplier) and the second shipping charges (that is, to the customer), as provided by the subject matter

of claim 1 of the present application.

Should the Examiner disagree therewith, Applicant requests that the Examiner cite by page and line number in Provisional application no. 60/212,124 where basis for disagreement can be found.

Independent claims 6 and 19 are patentably distinct from the cited art for at least similar reasons.


Accordingly, for at least the above-stated reasons, Applicant respectfully submits that independent claims 1, 6 and 19, and the claims depending therefrom, are patentable over the cited art.

In view of the remarks hereinabove, Applicant submits that the application is now in condition for allowance. Therefore, Applicant earnestly solicits the allowance of the application.

If a petition for an extension of time is required to make this response timely, this paper should be considered to be such a petition. The Patent Office is hereby authorized to charge any fees that may be required in connection with this amendment and to credit any overpayment to our Deposit Account No. 03-3125.

If a telephone interview could advance the prosecution of this application, the Examiner is respectfully requested to call the undersigned attorney.

Respectfully submitted,

  
Paul Teng, Reg. No. 40,837  
Attorney for Applicant  
Cooper & Dunham LLP  
Tel.: (212) 278-0400